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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,816	07/28/2003	Robert Metzger	5490-000333	5865
27572 7590 07/13/2007 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			EXAMINER SWIGER III, JAMES L	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 07/13/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/628,816

Applicant(s)

METZGER, ROBERT

Examiner

James L. Swiger

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 31-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/28/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/2/2007 has been entered.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 8-9, and 12-20 and 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowman et al. (US Patent 4,952,213). Bowman discloses a positioning member (Fig. 1, 66), a guiding member (56) that may be a first member, a resecting member (40). The device further includes a selection portion (58) that is considered a second assembly that also has a portion considered a sleeve at least around the selecting portion. Bowman et al. also has a third portion that has a sleeve portion (116) and is operable to connect to a first guiding member and that allows for translation along an extending portion (arrow between 98 and 16) and wherein each member is adapted to their respective movements. Note that the resecting member (40) is also considered a rod with a bone engaging section (144) and a first guiding member engaging section located adjacent to arrow (142). The resecting head is movable along

the axis of the resecting tool. The device also includes additional sleeve (80) and stop (46).

It is also noted that the guiding member may also be adjustably securable (See arrow in Fig. 1) along an axis relative to bone. The resecting device is adapted to adjustably position at both a first and second angles, wherein both may be distinct, because of the rotational movement (see arrows 70, and degree marks on 72). The depth markers (46) are capable of selecting an axial depth that work with a guiding/selecting member (56) that sleeves the rod to select proper depth. Bowman et al. also disclose what is considered a spacer (144) that is disposed in between the bone and the first guiding member and effectively limits the translation of the resection tool.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-7 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman et al. '213 in view of Sioufi (US Patent 5,409,489). Bowman et al. disclose the claimed invention except for a guiding member having a first and second portions. Sioufi disclose a device having a first portion (53) and a second portion (51) that may allow for a variation in angle or for patient differences (see Col. 7, lines 30-45). It would

have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Bowman et al. having at least a guiding member with a first and second portions in view of Sioufi to better adjust the device for use.

Claims 4-5 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman et al. '213. Bowman et al. '213 discloses the claimed invention except for a milling head ranging from .5 cm to approx 3.0 cm or a shaft with a width of 0.25 to 2.0 cm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a milling head ranging from .5 cm to approx 3.0 cm or a shaft with a width of 0.25 to 2.0 cm, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

### ***Response to Arguments***

Applicant's arguments filed 5/2/2007 have been fully considered but they are not persuasive. With regards to the amendments filed above, it is still held that the prior art of record meets the claim limitations. The positioning arm may be considered at least generally proximate to the resecting portion because it may rotate and be considered at least generally proximate. The claim is directed to resecting at least a bone portion, so the device could be manipulated to resect a bone portion that could place the positioning member at least generally proximate the resecting member.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JLS

5/8/07



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SUPERVISORY PATENT EXAMINER